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10/783,971

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Oscar af Strom

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12/11/2006

PATWRITE LLC

408 W. MAIN ST.

MARSHALLTOWN, IA 50158-5759

EXAMINER

MCCLELLAND, KIMBERLY KEIL

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---|--|--|
| Office Action Summary | Application No. 10/783,971 | Applicant(s) STROM, OSCAR AF | |
| | Examiner Kimberly K. McClelland | Art Unit 1734 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 and 15-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10 and 15-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3. As to claim 10, there is no support in the current specification for an "image forming layer", or any information which would allow one of ordinary skill in the art to make or use such a layer. Also, it is unclear how one would provide such a layer on the composite sheet, and then proceed to form the same layer once the adhesive is placed in contact with the adhesive.

4. As to claim 16, it is unclear if support exists for a "releasable support sheet layer is a paper coated with a dissolvable rubber-based hot melt adhesive." Is this adhesive layer the same layer of the composite sheet discloses in claim 10, or a second adhesive layer? A second adhesive layer is not disclosed in the current specification so as to enable one of ordinary skill in the art to make or use the current invention.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 10 and 15-16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The structure of the composite sheet in independent claim 10 is unclear. Claim 10 includes the language, "a rubber-based hot melt adhesive layer adjacent to the plastic film layer and an image forming layer having an inner layer adjacent with the rubber-based hot melt adhesive layer" in lines 4-6. However, lines 9-10 require applying the composite sheet to an image with the rubber based hot melt adhesive layer in contact with the image. It is unclear how the rubber-based hot melt adhesive layer can be adjacent to both the plastic film layer and the image forming layer, and still come into contact with the image. Clarification is required. For the purposes of examination, examiner has assumed that the composite sheet only includes the support sheet, the plastic film, and the adhesive layer, which is applied to the image appearing on the paper surface.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 10 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,985,602 to Stuart in view of U.S. Patent No. 6,270,871 to Scholz et al.

9. With respect to claim 10, ~~as Stuart~~^{Stuart} discloses a transfer method of a composite sheet, including providing a composite sheet having a releasable support sheet layer (10), a plastic film layer adjacent to the releasable support sheet (12; column 4, lines 6-18), an adhesive layer (13) adjacent to the plastic film layer (12) and an image forming layer (20) having an inner side layer adjacent with the adhesive layer (13) and an outer side layer adjacent with the paper (21) which contains the image (20) and covers the outer side layer of the image forming layer; applying said composite sheet to an image (20) with said adhesive layer (13) in contact with said image (20) to produce an image forming layer (See Figure 3); obtaining a decal by washing away the paper containing the image to be transferred and exposing the outer side layer of the image forming layer (column 2, lines 33-39); positioning the decal so that the outer side layer of the image forming layer contacts the surface (22); applying heat to the releasable support sheet layer wherein the adhesive migrates through the image forming layer transferring the image into the surface; and removing the releasable support sheet layer (See Figures 4-5). However, Stuart does not specifically disclose a rubber-based hot melt adhesive.

10. Scholz et al. discloses a method of using pressure-sensitive adhesive constructions with removable substrates, including rubber-based hot melts adhesives (column 7, lines 26-30; column 14, lines 63-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the rubber-

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based hot melt adhesive taught by Scholz et al. in the transfer method of a composite sheet disclosed by Stuart. The motivation would have been to use flexible, low-cost materials to form the composite sheet (column 4, lines 11-13).

11. As to claim 15, Stuart discloses the paper (10) is a one-sided coated paper (11; See Figure 4).

12. As to claim 16, Stuart discloses the releasable support sheet layer is a paper (10) coated with an adhesive (13). However, Stuart does not specifically disclose a dissolvable rubber-based hot melt adhesive.

13. Scholz et al. discloses a method of using pressure-sensitive adhesive constructions with removable substrates, including a dissolvable rubber-based hot melts adhesives (column 7, lines 26-30; column 7, lines 35-45; column 14, lines 63-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the dissolvable rubber-based hot melt adhesive taught by Scholz et al. in the transfer method of a composite sheet disclosed by Stuart. The motivation would have been to use flexible, low-cost materials to form the composite sheet (column 4, lines 11-13).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 4,70,899 to Robinson discloses a method of decorating wood, including washing the paper off the image to form a decal, prior to transferring the image to a final substrate. U.S. Patent No. 4,685,984 to Powers et al.

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discloses an image transfer method, including removing the paper backing by washing
(See Abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly K. McClelland whose telephone number is (571) 272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris A. Fiorilla can be reached on (571)272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kim McClelland

KKM

[Signature]
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2010/07/23